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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/092,033	03/05/2002	Stephen F. Fulghum	301489.1003-113	7761

207 7590 08/28/2006

WEINGARTEN, SCHURGIN, GAGNEBIN & LEOVICI LLP  
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BOSTON, MA 02109

EXAMINER

LEUBECKER, JOHN P .

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 08/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/092,033		FULGHUM, STEPHEN F.	
	<b>Examiner</b>		<b>Art Unit</b>	
	John P. Leubecker		3739	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 August 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) 12-20 and 27-35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 21-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>2/27/06</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 8, 2006 has been entered.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-11 and 21-26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Note reasons set forth in numbered paragraph 4 of paper number 11172004 and elaborated upon in numbered paragraph 13 of paper number 08042005.

4. Claim 7 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that

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the inventor(s), at the time the application was filed, had possession of the claimed invention.

Note reasons set forth in numbered paragraph 4 of paper number 08042005.

***Claim Rejections - 35 USC § 103***

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 1-6, 8-11, 21, 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaneko et al. (U.S. Pat. 5,749,830) in view of Poindexter et al. (U.S. Pat. 5,979,523) for the reasons set forth in numbered paragraph 6 of the previous Office Action, paper number 08042005.

As to the newly added limitations to claim 1, the transmission of light by the light sources of Kaneko et al. are enabled/disabled (e.g., operable) by signals from a timing controller (907) and computer (941), both of which would anticipated a control system. Since the excitation light and reference light are sequentially transmitted (by 916), the new limitation of claim 8 is met.

7. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kaneko et al. in view of Poindexter et al. and further in view of Perelman et al. (U.S. Pat. 6,091,984) for the reasons set forth in numbered paragraph 7 of the previous Office Action, paper number 08042004.

8. Claims 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaneko et al. in view of Poindexter et al. and further in view of Groner et al. (U.S. Pat. 6,104,939) for the reasons set forth in numbered paragraph 8 of the previous Office Action, paper number 08042005.

***Response to Arguments***

9. Applicant's arguments filed August 8, 2006 have been fully considered but they are not persuasive.

Regarding the rejection of claim 7 under 35 U.S.C. 112, first paragraph, Applicant cites a sentence (page 5, lines 20-21) in the Summary of the Invention that mentions the simultaneous transmission of the excitation light and reference light. This sentence appears to prove the Examiner's point. It is noted that the simultaneous transmission of light is not at issue—what is at issue is *which* light is simultaneously transmitted. As previously pointed out, the specification confusingly refers to both the visible image light (RGB) and the nominally red reference image light as “reference light”. Claim 1 requires the “reference light” to include red, green and blue wavelength bands and be transmitted through a common optical path as the excitation light (see claim 1). The portion of the specification (page 5, lines 20-21) referred to by Applicant is apparently referring to simultaneous transmission of the excitation and nominally red reference image light as per page 5, lines 9-19. What Applicant has not shown support for is the simultaneous transmission of the visible image light (including red, green and blue) down a common optical path with the excitation light in the combination of elements as claimed in claims 1 and 7.

Regarding the rejection of claims 1-11 and 21-26 under 35 U.S.C. 112, first paragraph, the Examiner has previously set forth his position with respect to this issue and it is being maintained. In view of Applicant's comments, the Examiner must note that Applicant's labeling of two-line sentence mentioning a laser diode (but not describing it in relation to any other elements of the claimed invention) as an "embodiment" of the invention is not well taken.

Regarding Applicant's arguments concerning the Poindexter ('423) reference, Applicant argues that Poindexter does not provide a "teaching or suggestion in this reference that such a source could be used to induce tissue autofluorescence in the claimed range suitable for diagnostic purposes". Since the Examiner has not relied on such a specific teaching, this argument is rendered moot. The Examiner was under the impression that it was the wavelength range of the diode laser that allowed it to induce tissue autofluorescence. Applicant did not discover the wavelength range of any new diode laser. The construction and use of these were known and used in the art at the time of filing Applicant's application (remarks filed August 30, 2004, page 8, second full paragraph). So why couldn't such known sources be used?

### ***Conclusion***

10. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114.

See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

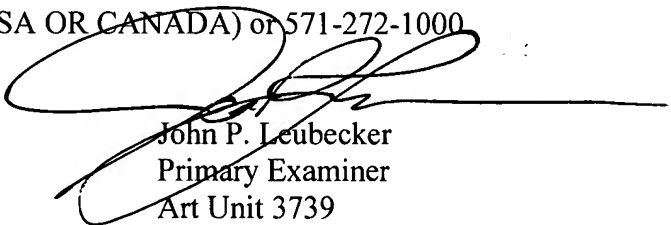
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Leubecker whose telephone number is (571) 272-4769. The examiner can normally be reached on Monday through Friday, 6:00 AM to 2:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



John P. Leubecker  
Primary Examiner  
Art Unit 3739

jpl